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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,427	02/15/2002	Sam M. Jyswook	67/064-091	3582
35096	7590	06/01/2004	EXAMINER	
VO. HAI				
ART UNIT			PAPER NUMBER	
1771				

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 0526

Application Number: 10/077,427
Filing Date: February 15, 2002
Appellant(s): JYAWOOK ET AL.

David J. Gaskey
For Appellant

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EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/05/2004.

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(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

Appellant's brief includes a statement that there are no related appeals or interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that the claims 1-7, and 15-20 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,458,301	HENDRIX	10-2002
6,602,064	CHEN et al	08-2003

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-7, and 15-20 are rejected under 35 U.S.C. 103(a) as being patentable over Hendrix (US 6,458,301) in view of Chen et al (US 6,602,064).

Hendrix teaches a weatherseal having the gripping portion and sealing portion made of foamed thermoplastic vulcanizates (column 4, lines 15-33). Hendrix teaches the gripping and sealing portions having a cross sectional dimension that selectively varies along a length of the weather stripping (figures 2-4). Hendrix does not specifically disclose the entire weather stripping formed from a microcellular material. Chen discloses that microcellular materials have smaller cell sizes and higher cell densities than conventional polymeric foams. Chen teaches that the unique cell structure of microcellular foams leads to several advantages over the conventional foams including

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improved properties and appearance (column 2, lines 50-60), which is important to the expectation of successfully practicing the invention of Hendrix. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the cellular foamed material in Hendrix by a microcellular foamed material as taught in Chen motivated by the desire to provide the foam having improved properties and appearance.

With regard to claims 4-6, and 17-19, Chen teaches a microcellular foamed material having a cell size less than 10 microns and a cell density less than 10^6 cells per cubic centimeter (column 2, lines 55-60). Chen also discloses such a variable would have been recognized by one skilled in the art as dependent upon the intended use of the product (column 7, lines 30-35). As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the microcellular foam material having the cell size and cell density instantly claimed because such is determined suitably depending on the intended use of the product. This is in line with *In re Aller*, 105 USPQ 233 which holds discovering the optimum or workable ranges involves only routine skill in the art.

With regard to claim 15, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the article of Hendrix as modified by Chen is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity (the sealing portion and base portion made of a microcellular foamed material). It is noted that if the applicant intends to rely on

Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Hendrix/Chen.

(11) Response to Argument

Appellant argues that the combination of Hendrix and Chen will not work due to differences in the process steps performed in Hendrix and Chen. The Hendrix reference requires heating the primary extrudate after it exists the die and then securing the secondary extrudate to the primary extrudate. This process is required for forming the weather seal of the Hendrix arrangement. On the other hand, Chen discloses that cooling extrudate as it exists the die is required to form the microceluar structure. Therefore, if one were to attempt to use a microcellular material within the Hendrix arrangement, the microcellular structure will not be formed at all. The examiner disagrees. Hendrix discloses that the first and second insert dies 120, 220 form corresponding first and second extrudates (column 6, lines 50-65). The first and second extrudates are connected together and cooperatively engage the primary die block 60 which has material flow path for the material of the extrudate. These two extrudates appear not to be separated from each other during the process of forming the weather seal. Likewise, it is clearly apparent that the first extrudate is not necessarily heated prior to being secured to the second extrudate. In view of Chen, the first and second extrudates are allowed to cool as they exist the die to form a microcellular material.

Therefore, the combination would provide a workable result and there is a *prima facie* case of obviousness. The motivation to combine the two cited references is sufficient and proper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to replace the cellular foamed material in Hendrix by a microcellular foamed material as taught in Chen motivated by the desire to provide the foam having improved properties and appearance. This is reasonably pertinent to the particular problem with which Appellant was concerned (Appellant's specification, last full paragraph 5 at page 1 and first two paragraphs 6 and 7 at page 2).

Further, appellant filed declaration under 37 CFR 1.132 regarding Commercial Success on 03/24/04. The affidavit has been entered and carefully reviewed. However, it does not place the instant claims in condition for allowance. To establish commercial success, Applicant bears the burden of showing that the commercial success is derived from the claimed invention. The commercial success must be shown to be directly derived from the invention claimed, "in a marketplace wherein the consumer is free to choose on the basis of objective principles and it must be shown "that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention." MPEP 716.03(b). The Applicant bears the burden of supporting the contention of nonobviousness by establishing a nexus between the claimed invention and evidence of commercial success. Also, the evidence provided must be commensurate in scope with the claims. Gross sales figures do not show commercial success absent evidence as to market share, or the

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time period during which the product was sold, or the normally expected sales in the market. Accordingly, the art rejections are thus sustained.

For the above reasons, it is believed that the rejections should be-sustained.

HV
May 26, 2004

Respectfully submitted,

Har Vo

Conferees

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